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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re United States Patent Application of:****Applicant:** Ray R. Eshraghi et al.**Application No.:** 10/767,107**Date Filed:** January 28, 2004**Title:** HYDROGEN STORAGE
SYSTEMS AND FUEL CELL
SYSTEMS WITH HDYROGEN
STORAGE CAPACITY**Docket No.:** 4172-121**Examiner:** Chuo, Tony S.H.**Art Unit:** 1746**Confirm. No.:** 4423**Customer No.:** 23448**FACSIMILE TRANSMISSION CERTIFICATE****ATTN: Examiner Tony S.H. CHUO****Fax No. (571) 273-8300**

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4

Number of Pages (including cover)

Steven J. Hultquist

September 10, 2006

Date

**DEMAND FOR IMMEDIATE RESCISSION OF IMPROPER SEPTEMBER 5, 2006 NOTICE
OF NON-COMPLIANT AMENDMENT, AS ISSUED BY THE USPTO IN DISREGARD OF
THE REQUIREMENTS OF 37 CFR 1.121 AND MPEP 714**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Request is hereby made for immediate rescission of the September 5, 2006 Notice of Non-Compliant Amendment, as improperly issued by the USPTO Legal Instruments Examiner who reviewed applicants' Amendment filed August 28, 2006 in response to the May 26, 2006 Office Action.

The Legal Instruments Examiner declared in the September 5, 2006 Notice of Non-Compliant Amendment that the August 28, 2006 Amendment was non-compliant for the reason stated in Paragraph 4.E. of the Notice that "[W]ithdrawn claims 31-34, 36, 41 and 44 status identifier is improper because of markings."

The Legal Instruments Examiner in this instance is in error and has failed to observe the provisions of 37 CFR 1.121 and MPEP 714. The "markings" (amendments) by the undersigned attorney were fully consistent with the status identifier of "(Withdrawn)" and such status identifier is fully proper.

Claims 31-47 were withdrawn pursuant to a restriction requirement in the May 26, 2006 Office Action. The applicants in their August 28, 2006 Amendment argued against such withdrawal, but properly indicated "(Withdrawn)" as the status identifier for all such claims 31-47. Applicants amended withdrawn claims 31-34, 36, 41 and 44, **and the status identifier "(Withdrawn)" is fully appropriate for such claims, consistent with the requirements of 37 CFR 1.121 and MPEP 714.**

37 CFR 1.121 provides in paragraph (c) as follows:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. **In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).**

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. **Only claims having the status of "currently amended," or "withdrawn" if also**

being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn-currently amended."

It therefore is apparent that (i) "withdrawn" claims can be amended, and (ii) such claims optionally can be but are not required ("may be identified...") to indicate the amended status.

Thus, an amended withdrawn claim can be labeled with either "(withdrawn)" or "(withdrawn-currently amended)." Either is fully proper.

The MPEP in Section 714 C.(A) is consistent with the above, in instructing that

"[F]or any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, **any claims which are non-elected must have the status identifier (withdrawn). Any non-elected claims which are being amended must have either the status identifier (withdrawn) or (withdrawn - currently amended) and the text of the non-elected claims must be presented with markings to indicate the changes.**" (emphasis added)

See also MPEP Section 714 C.(E), which discusses alternative status identifiers:

"E) **Acceptable Alternative Status Identifiers:** To prevent delays in prosecution, the Office will waive certain provisions of 37 CFR 1.121 and accept alternative status identifiers not specifically set forth in 37 CFR 1.121©. See *Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121©*, O.G. (July 5, 2005). Accordingly claim listings that include alternative status identifiers as set forth below may be accepted if the amendment otherwise complies with 37 CFR 1.121.

Status Identifiers Set Forth in 37 CFR 1.121 ©	Acceptable Alternatives
1. Original	Original Claim; and Originally Filed Claim
2. Currently amended	Presently amended; and Currently amended claim
3. Canceled	Canceled without prejudice; Cancel; Canceled; Canceled herein; Previously canceled; Canceled claim; and Deleted
4. Withdrawn	Withdrawn from consideration; Withdrawn – new; Withdrawn claim; and Withdrawn – currently amended
5. Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim
6. New	Newly added; and New claim
7. Not entered	Not entered claim

[emphasis added]."

It therefore is amply clear that "Withdrawn" is a fully proper and appropriate status identifier for a claim that although withdrawn has been amended.

The Legal Instruments Examiner therefore is requested to take cognizance of the foregoing remarks, the specific applicable provisions of the Code of Federal Regulations and the MPEP provisions promulgated thereunder, and to immediately withdraw the Notice of Non-Compliant Amendment in order to correct the USPTO error in the issuance of the September 5, 2006 Notice.

Respectfully submitted,



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